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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,489	11/13/2001	Chander P. Chawla	214453	5624
23460	7590	11/17/2004		
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			EXAMINER JACKSON, MONIQUE R	
			ART UNIT 1773	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/008,489

Applicant(s)

CHAWLA ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed 8/16/04 has been entered. New claims 50-65 have been added.

Claims 1-65 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A claim in which one ingredient is defined so broadly that it reads upon a second does not meet the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Ferm and Boynton*, 162 USPQ (BdPatApp & Int 1969.) In the instant case, the terms “photoinitiator” and “a component selected from the group consisting of acyclic thiols, heterocyclic compounds of the formula R-SH or R<sup>1</sup>-R<sup>2</sup>, and mixtures thereof” are so broadly defined that they may read upon one another.

#### *Claim Rejections - 35 USC § 103*

5. Claims 1-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ha et al or WO'368. The teachings of Ha et al and WO'368 are discussed in detail in the prior office action. In general, the references teach a radiation-curable adhesive composition and disc lacquer for a digital versatile disc (DVD) wherein the adhesive comprises a) UV or radiation curable acrylate component that undergoes polymerization when exposed to radiation, b) a non acrylate

functional reactive diluent comprising a component capable of radical polymerization, c) at least one acrylate functional reactive diluent, d) about 0.5wt% to about 10wt% of at least one radical forming sulfur compound, preferably a thiol compound and e) optionally about 0.1wt% to 15wt% of one or more photoinitiators which may be mercaptobenzothiazoles (*formula 2*), mercaptobenzooxazoles (*formula 1*) or hexaryl bisimidazole, wherein the photoinitiator is required for fast UV curing and wherein a mixture of photoinitiators may be utilized. The adhesive may further comprise conventional additives including UV absorbers such as benzotriazole (*formula 10*) (Page 23, line 2.) Hence, Ha et al and WO'368 clearly suggest utilizing compounds in the adhesive that read upon the instantly claimed component in amounts that would provide corrosion inhibiting properties and further, though Ha et al and WO'368 list various compounds that may be utilized as the photoinitiator that also read upon the corrosion inhibiting component of the instant invention, one having ordinary skill in the art at the time of the invention would have been motivated to utilize mercaptobenzothiazoles (*formula 2*) or mercaptobenzooxazoles (*formula 1*) wherein Ha et al and WO'368 specifically list these compounds in their claims and hence provide guidance to one having ordinary skill in the art to select either of these compounds. Though Ha et al and WO'368 do not specifically teach the compounds as instantly claimed in Claims 7-10 and 13-14, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the instantly claimed compounds considering they are structurally and functionally equivalent to those compounds taught by Ha et al or WO'368. Further, with regards to instant Claims 50-61, Ha et al and WO'368 teach one or more photoinitiators is present in sufficient quantity to provide fast cure speed, reasonable cost, good surface through cure and lack of yellowing upon aging with typical

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amounts, for example, of about 0.1wt% to 15wt%. Hence, the Examiner takes the position that the amount taught by Ha et al or WO'368 of about 0.1wt% reads upon the amounts as instantly claimed and further, that one having ordinary skill in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum amount of mercaptobenzothiazoles or mercaptobenzoxazoles and/or photoinitiator to provide the desired cure properties for a particular end use given the reasonable expectation of success wherein Ha et al and WO'368 specifically teach that the amount is a result-effective variable.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection. With regards to Applicant's arguments regarding Claims 50-61, the Examiner first notes that considering the compounds provided with amounts in these claims may also read upon the term "photoinitiator", the amounts are moot since amounts in excess of these cited values may be attributed to the photoinitiator. Further, the Examiner takes the position that the amounts taught by the prior art of "about 0.1wt%" reads upon the ranges "up to about 0.1wt%", "up to about 0.05wt%", and "up to about 0.01wt%" given the small quantities and given the absence of a showing of unexpected results with regards to 0.05wt% and 0.01wt% in respect to 0.1wt%.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

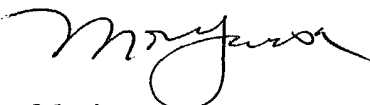
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
November 9, 2004